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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,990	12/09/2003	Wade M. Mattar	12780-026001	2769
26171	7590	05/04/2004	EXAMINER	
FISH & RICHARDSON P.C. 1425 K STREET, N.W. 11TH FLOOR WASHINGTON, DC 20005-3500			RAEVIS, ROBERT R	
			ART UNIT	PAPER NUMBER
			2856	

DATE MAILED: 05/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/729,990	MATTAR, WADE M.
	Examiner	Art Unit
	Robert R. Raevis	2856

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-38 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) \_\_\_\_\_ is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) 1-38 are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 2,17,36 drawn to method/system to calibrate a flow meter with respect to zero, classified in class 73, subclass 1.88.
- II. Claims 6,7,20,34, drawn to method/system to calibrate a meter based upon determination of whether density falls within a range of densities, classified in class 73, subclass 1.01+.
- III. Claims 8,9,21,35, drawn to method/system to calibrate a meter based upon determination of mathematical relationship relating to density, classified in class 73, subclass 1.01+.
- IV. Claims 10-12,22-24,29-32, drawn to method/system to calibrate a meter based upon configuration of flow elements, classified in class 73, subclass 1.01+.
- V. Claims 13,14,25,26,37,38, drawn to method/system to calibrate a meter based upon void volume measurement, classified in class 73, subclass 1.01+.

Claims 4,5,18,19,33 links II, III.

Claim 3 links II,III,IV,V.

Claims 1,15,16,27,28 links I-V.

Note was made of page 6, lines 12-16, which relates Applicant's term "flowmeter" to **any** device that measures flow, density or "*other parameters*" (italics added, p. 6, line 15) that flows through a conduit. While this definition appears to be against the normal meaning of the word, the claims were evaluated in light of this definition. In addition, use of the phrases "one or more of the following features" (p. 2, line 3, and other locations) and "may include" (p. 3, line 19), along with other portions of the SUMMARY appear to suggest that the various possibilities are subcombinations of a single embodiment, as opposed to a plurality of embodiments.

Inventions I (apparatus claims) and II-V (apparatus claims) are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because all limitations II-V were not found in I. The subcombination has separate utility such as an apparatus to calibrate any meter for a mid level value (i.e. non-zero).

Inventions I (method claims) and II-V (method claims) are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination

as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because all limitations II-V were not found in I. The subcombination has separate utility such as claimed because all limitations II-V were not found in I. The subcombination has separate utility such as a method to calibrate any meter for a mid level value (i.e. non-zero).

Inventions V (apparatus claims) and II-IV (apparatus claims) are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because all limitations II-VI were not found in V. The subcombination has separate utility such as an apparatus to calibrate any meter that measures incompressible liquid.

Inventions V (method claims) and II-IV (method claims) are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the

combination as claimed does not require the particulars of the subcombination as claimed because all limitations II-V were not found in V. The subcombination has separate utility such as claimed because all limitations II-V were not found in I. The subcombination has separate utility such as a method to calibrate any meter that measures incompressible liquid.

Inventions IV (apparatus claims) and II,III (apparatus claims) are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because all limitations III,III were not found in IV. The subcombination has separate utility such as an apparatus to calibrate any meter with a single configuration system (i.e. one that employs a single tank with a valve).

Inventions IV (method claims) and II,III (method claims) are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because all limitations II,III were not found in IV. The subcombination has

separate utility such as claimed because all limitations II, III were not found in IV. The subcombination has separate utility such as a method to calibrate any meter with a single configuration system (i.e. one that employs a single tank with a valve).

Inventions II (apparatus claims) and III (apparatus claims) are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because all limitations III were not found in II. The subcombination has separate utility such as an apparatus to calibrate any meter employing a mathematical relationship that provides for a separate calibration value for any individual parameter value.

Inventions II (method claims) and III (method claims) are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because all limitations IIV were not found in I. The subcombination has separate utility such as claimed because all limitations III were not found in II. The subcombination has

separate utility such as a method to calibrate any meter employing a mathematical relationship that provides for a separate calibration value for any individual parameter value.

Because these inventions are distinct for the reasons given above and the search required for each group is different, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert R. Raevs whose telephone number is 571-272-2204. The examiner can normally be reached on Monday to Friday from 7am to 4pm. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Rawn

RAENIS